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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,508

09/28/2006

Yuichi Inada

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1763

32294 7590 12/13/2007
SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER

BODAWALA, DIMPLE N

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

12/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/594,508	INADA ET AL.	
	Examiner	Art Unit	
	Dimple N. Bodawala	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/28/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, drawn to a mold for molding a disk.

Group II, claim(s) 7-11, drawn to a mirror surface disk for a mold.

Group III, claim(s) 12, drawn to a molded product produced by charging a molding material into a cavity of a mold for molding a disk.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is either obvious or anticipated by U S 5,882,700 and claim 12 is obvious or anticipated by U S 4,452,748. Accordingly, the special technical feature linking the three inventions, the mirror-surface disk, does

not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, restriction is appropriate.

3. During a telephone conversation with Douglas Goldhush on October 17, 2007 a provisional election was made without traverse to prosecute the invention of Group II, drawn to a mirror surface disk, claims 7-11.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-6 and 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant's election of Group II in the reply on 10/17/2007 (a message left on Examiner's phone by Applicant's representative) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

7. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

8. IDS is objected because disclosure of the instant applicant discloses foreign document such as JP 2002-222545, but does not cite on the IDS form.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 7 is vague and indefinite because it is unclear about the means of claimed limitation "the others of first and second mirror disk", and further how and which other of the mirror surface disk is involved to form the pattern on a front end surface.

12. Claim 8 recites the claimed limitation "wherein a groove" in lines 1-2, which lacks sufficient antecedent basis because claim 8 is depended on claim 7, wherein claim 7 does not cite the limitation earlier, which makes the scope of the claim indeterminate.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

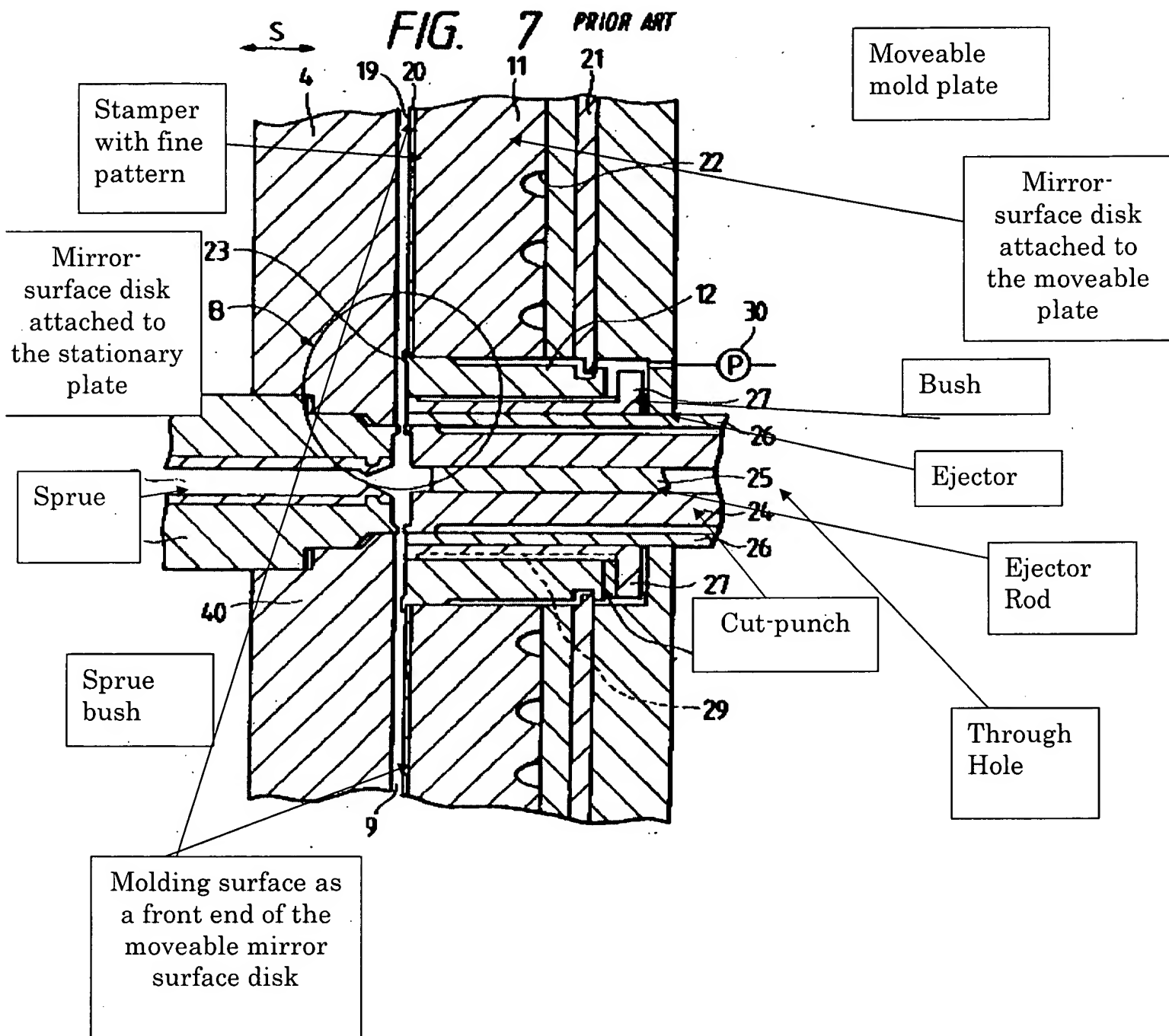
14. Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama et al. (U S Patent No. 5,006,058).

15. Maruyama et al. ('058) discloses an apparatus for injection molding information recording disk which comprises a mirror-surface disk (4,11) for a mold (1,2) for molding a disk.

16. It further discloses an apparatus having a first mold plate (1), a first mirror surface disk (4) attached to the first mold plate (1), a second mold plate (2) disposed to advanced and retreat in relation to the first mold plate (1), a second mirror surface disk (11) attached to the second mold plate (2) and forming a cavity in cooperation with the first mirror surface disk in a mold clamped condition (See figure 7).

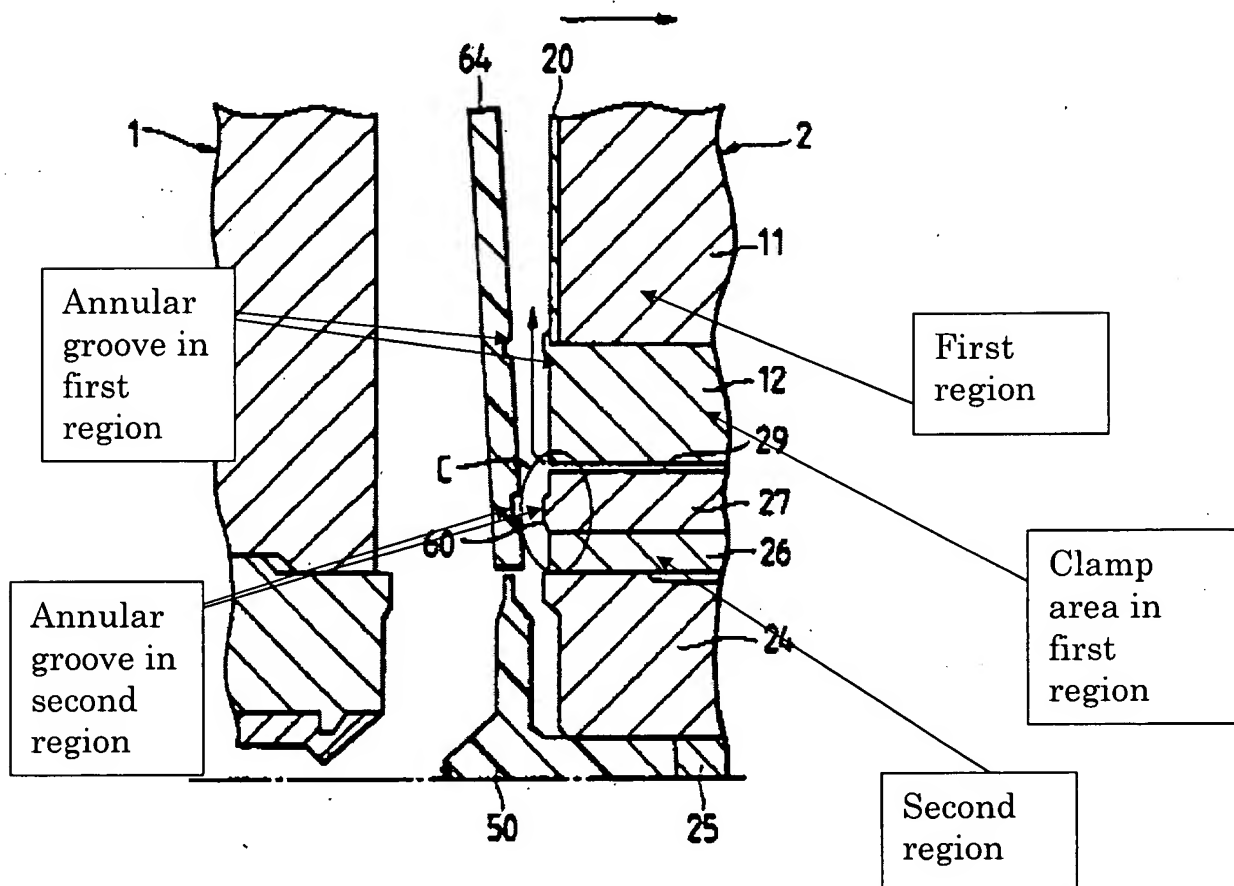
17. It further discloses an apparatus having a stamper (20) attached to a second mirror surface disk (11) and having a fine pattern formed on a front end surface (19) thereof, and a bush (6) extending there through the others of the mirror surface disk (See figure 7).

18. It further discloses a through hole for disposing the bush (27) which is formed radially inward of a region for forming a clamp area (See figure 7). It further teaches that the a first region provided to extend radially outward from an outer circumferential edge of the through hole projects from a second region provided to extend radially outward from the first region so as to form a step between two regions (See figures 1 and 7).



19. It further discloses annular grooves (64c and 64e) for forming a stack rib which is formed on the front end surface (19) at a predetermined location (See figure 1, col.3 lines 32-36; col.6 lines 15-21).

20. It further teaches that the groove (64c, 64e) is formed between the first and second region (See figure 7 and 1), wherein the first region is a region for forming a clamp area (12) (See figure 7).



21. Figure 9 further teaches that the groove (64c) is formed in the first region and the groove (64e) is formed in the second region.

22. Maruyama et al. ('058) discloses all claimed structural limitations as discussed above, and, thus, claims are anticipated.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTOL-892 for further references related to the mold with the mirror-surface disk).

24. Lange et al. (U S Patent No. 4,452,748) discloses a mold with the mirror surface disks (1,7) having annular grooves (18,19) in two different region.

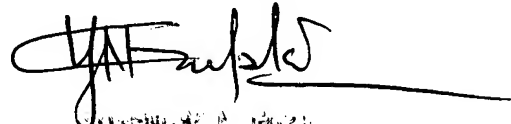
25. Asai (U S Patent No. 5,804,229) discloses a mold (10) for molding disc which comprises mirror surface blocks (15, 21), stamper (20), cavity (19), wherein the mirror surface disk (15) comprises an annular groove (34) which leak outwards, Wherein the groove is involved to increase the performance of compressed air for releasing molded disc from the stamper, which inherently teaches that the groove is involved to proved better clamping means during the molding process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dimple N. Bodawala whose telephone number is (571) 272-6455. The examiner can normally be reached on Monday - Friday at 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra N. Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DNB


YOGENDRA N. GUPTA
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 1791